

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1 and 3-9 are now present in this application. Claims 1, 3 and 5 are independent.

Claims 1, 3 and 5-9 have been amended, and claim 2 has been canceled. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

Priority Under 35 U.S.C. § 119

Applicants thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

Information Disclosure Citation

Applicants thank the Examiner for considering the reference supplied with the Information Disclosure Statement filed October 15, 2004, and for providing Applicants with an initialed copy of the PTO/SB/08 form filed therewith.

Rejection Under 35 U.S.C. § 102

Claims 1-3 and 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,730,635. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is inherent must necessarily be disclosed. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

If the PTO fails to meet this burden, then the applicant is entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the applicant to come forward with evidence and/or argument supporting patentability.

Moreover, as stated in MPEP § 707.07(d), where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated.

Additionally, findings of fact and conclusions of law by the USPTO must be made in accordance with the Administrative Procedure Act, 5 U.S.C. §706(A), (E) (1994). Zurko v. Dickinson, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999).

A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present. Rosco v. Mirro Lite, 304 F.3d 1373, 1380, 64 USPQ2d 1676 (Fed. Cir. 2002). The dispositive question regarding anticipation is whether one skilled in

the art would reasonably understand or infer from the prior reference's teaching that every claim feature or limitation was disclosed in that single reference, Dayco Products, Inc. v. Total Containment, Inc., 329 F.3d 1358, 1368, 66 USPQ2d 1801 (Fed. Cir. 2003).

Applicants respectfully submit that Linden does not anticipate originally filed claims 1-3 and 5, or amended claims 1-3 and 5, for the following reasons:

Firstly, with respect to claim 1, which has been amended to include the subject matter recited in dependent claim 2, Linden's control port 54 does not provide a control fluid to maintain its valve closure member 46 in a closed position under a pressure differential as between the pressure applied to one side of the closure member 46 (which is not applied to the closure member 46 to lift the closure member 46 off of the valve seat 38), and the pressure applied to the other side of the closure member 46 through the control port 54 (which actually is directed in directions 66 and 68 to open the valve) to close the valve, as recited. In other words, Linden is not constructed as is the claimed invention, nor does Linden operate as does the claimed invention.

Accordingly, the Office Action fails to make out a *prima facie* case of anticipation of the invention recited in claims 1-3 and 5 by Linden.

Reconsideration and withdrawal of this rejection of claims 1-3 and 5 are respectfully requested.

Claims 1 and 4 stand rejected under 35 USC § 102(b) as being anticipated by U.S. Patent 4,056,965 to Heiser. This rejection is respectfully traversed.

This rejection is moot as claim 1 has been amended to include the subject matter recited in dependent claim 2.

Reconsideration and withdrawal of this rejection of claims 1 and 4 as being anticipated by Heiser are respectfully requested.

Rejections under 35 USC § 103:

Claim 6-8 stand rejected under 35 USC § 103(a) as being unpatentable over Linden in view of U.S. patent 4,300,748 to Kreely and Helser. This rejection is respectfully traversed.

Because the rejection is based on 35 U.S.C. § 103, what is in issue in such a rejection is "the invention as a whole, "not just a few features of the claimed invention. Under 35 U.S.C. §103, " [a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. See Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. § 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led

to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v Delta Resins & Refactories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir.

1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the applicant to come forward to rebut such a case.

Initially, Applicants respectfully submit that claim 5, from which claims 6-8 depend, is not disclosed by Linden, for reasons discussed above. For reasons explained above, Linden is not constructed as is the claimed invention, nor does Linden operate as does the claimed invention.

Nor are Kreely or Heiser applied to remedy the aforesaid deficiencies of Linden. So, even if one of ordinary skill in the art had a proper incentive to modify Linden in view of the two secondary references to Kreely and Heiser, the so-modified version of Linden would neither disclose, suggest, or otherwise render obvious, the claimed invention.

Accordingly, the Office Action does not make out a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection of claims 6-8 are respectfully requested.

Claim 9 stands rejected under 35 USC § 103(a) as being unpatentable over Linden,

Kreely and Heiser, as applied in the rejection of claim 8, and further in view of U.S. patent 6,568,416 to Tucker et al. (“Tucker”). This rejection is respectfully traversed.

Applicants respectfully submit that claim 8, from which claim 9 depends, is not rendered obvious by the aforementioned Linden-Kreely-Heiser reference combination, for reasons discussed above. Moreover, Tucker is not being applied to remedy the shortcomings of the aforementioned Linden-Kreely-Heiser reference combination.

So, even if one of ordinary skill in the art had a proper incentive to modify the aforementioned Linden-Kreely-Heiser reference combination, the so-modified version of Linden-Kreely-Heiser would neither disclose, suggest, or otherwise render obvious, the claimed invention.

Furthermore, Linden appears to be directed to a surgical valve, not an irrigation system in an agricultural field, as is Tucker, and the Office Action fails to explain why one of ordinary skill in the art would have a proper incentive to modify Linden’s surgical valve and use it in an irrigation system setup. These significant differences between the references teach away from making the proposed modification of Linden.

Accordingly, the Office Action does not make out a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection of claim 9 are respectfully requested.

Additional Cited References

Because the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

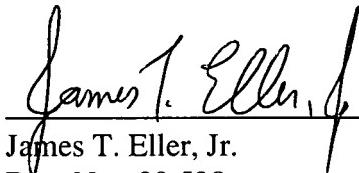
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: August 13, 2007

Respectfully submitted,

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